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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,846	12/30/1998	KAZUOMI OISHI	35.G2331	2585

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EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/222,846

Applicant(s)

OISHI, KAZUOMI

Examiner

Douglas J. Meislahn

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment filed 13 November 2002 that amended claims 1, 4, 8-10, 12, 14, 18, 20, and 22.

***Response to Arguments***

2. Applicant's arguments filed 13 November 2002 have been fully considered but they are not persuasive. Applicant concedes that the keys in Shibata et al. can be created, changed, and deleted by a user but then argues that, because the keys are maintained in a memory internal to the general device disclosed by Shibata et al., they are not "from an external source." The user in Shibata et al. is not internal to the general device and hence reads on an external source. Nothing in applicant's claims precludes keys from being maintained in the device prior to encryption.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., all versions of an encryption key must be deleted) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's argument with respect to Harrison is presaged on the understanding that the claims disallow any version a key, even a scrambled version thereof, to remain after encryption. This understanding is inconsistent with the claim language, and hence the argument is unpersuasive. Even assuming that the claims supported this limitation, the existence of scrambled keys

would not distinguish Harrison from the claims. To argue otherwise would imply that the encrypted data also needed erasing to eliminate all traces of the key. After all, the encrypted data is also dependent upon the encryption key and can be used in its recovery.

4. In response to applicant's argument that a combination of Shibata et al. and Harrison would render Harrison useless, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8, 10-14, 18, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. (5535277) in view of Harrison (5870468).

In their abstract, Shibata et al. disclose a scanner section that reads documents, meeting the limitations of applicant's conversion means. The operation section, element 7 in figure 1, reads a key that is input from a user, who reads on an external source. The limitations of the second clause are hereby met. Table 1 and lines 43-44 of column 4 read on a first storage means for storing encryption keys received from the reading means. Buffers inherent to the encryption/decryption circuit (element 403) meet the limitations of a second storage means for storing encryption keys during encryption. The abstract stipulates that image data is encrypted, reading on the fifth clause of claim 1. See figure 2 for the key. While they do allow for erasure of the encryption keys, Shibata et al. do not say that the key is erased when the encryption process is completed. Harrison teaches deleting the key used to encrypt files (which can include images) in elements 18 and 19 of figure 2. As noted in lines 20-22 of column 2, erasure of the encryption key protects the encrypted files. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to erase the encryption keys in Shibata et al. upon the completion of encryption as taught by Harrison, thereby protecting the encrypted files.

With respect to claims 18, 20, and 22, Harrison teaches a key encrypting key being input from the outside in element 8 of figure 1. Encryption means are inherent to

key encryption keys. Element 9 in figure 1 renders obvious storing the key encrypting key is a plurality of storage means. Encrypting data before encrypting the key would be obvious to a person of ordinary skill in the art.

8. Claims 7, 9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. and Harrison as applied to claims 1, 8, and 18 above, and further in view of Schneier.

Shibata et al. and Harrison show a system in which images are encrypted, with the encryption key being erased after encryption. An encrypted copy of the encryption key is maintained. They do not say that the key is encrypted with a key based on public key cryptography. Schneier teaches encrypting keys with public keys on page 48. This securely allows decryption of a key by one recipient. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the key in Shibata et al. and Harrison with a public key as taught by Schneier so as to allow decryption by only one recipient. Encrypting just the message with a public key would also be obvious, especially for small files.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Knapczyk (5131040).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



DJM  
December 10, 2002

Douglas J. Meislahn  
Examiner  
Art Unit 2132



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